

REMARKS

This Response and Amendment is filed in response to the Office Action dated July 5, 2005.

Claims 2-8 and 10-30 are pending in this application. The Applicant gratefully acknowledges the Examiner's indication that Claims 21-23 contain allowable subject matter. By this Amendment, Claims 10, 11, 19, and 21 are amended, leaving Claims 2-8, 12-18, 20, and 22-30 unchanged. Claims 2-8 and 10-30 are presented for consideration by way of the present Response and Amendment.

On page 2 of the Office Action, Claim 19 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asks whether the transfer mechanism claimed in Claim 19 is different from the transfer mechanism claimed in Claim 10. By this Amendment, Claim 19 is amended to overcome the Examiner's 35 U.S.C. §112 rejection of Claim 19. Accordingly, the Applicant respectfully requests withdrawal of the 35 U.S.C. §112 rejection of Claim 19.

Also on page 2 of the Office Action, Claims 2-8, 10, 13, 18-20, and 24-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,852,745 issued to Lemaire et al. (hereinafter "Lemaire") in view of U.S. Patent No. 1,667,483 issued to Leof (hereinafter "Leof"). On page 3 of the Office Action, Claims 14-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lemaire in view of Leof. On page 4 of the Office Action, Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lemaire in view of Leof, and further in view of U.S. Patent No. 6,623,236 issued to Barnes (hereinafter "Barnes").

Independent Claim 10 recites (underlining added for emphasis):

A storage device for storing trays, comprising:
a first rotatable member;
a second rotatable member positioned opposite the first
rotatable member, the first and second rotatable members
adapted to selectively support at least one tray therebetween; and
at least one transfer mechanism including a lifter, the same
lifter being movable relative to the tray to both selectively insert

and remove the tray between the first and second rotatable members.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

Neither Lemaire, Leof, nor their combination teach or suggest a transfer mechanism including a lifter, the same lifter being movable relative to a tray to both selectively insert and remove the tray between first and second rotatable members. Rather, Lemaire discloses a first pusher 11 configured to lower a goblet R from a station 3 and a separate, second pusher 10 configured to raise defective goblets R into a storage magazine 13. After goblets R are lowered onto a conveyor C by the first pusher 11, the goblets R are conveyed beneath a cell 4 which scans the goblets R to detect defects. If a defect is detected, the second pusher 10 is extended from a cylinder housing 8 to raise the defective goblets R into the storage magazine 13. Lemaire fails to teach or suggest that the same pusher, either pusher 10 or pusher 11, can be used to both selectively insert and remove goblets R with respect to the storage magazine 13 or the station 3.

Leof suffers from the same deficiencies as Lemaire. With reference to FIGS. 1 and 5, Leof discloses a liquid dispenser including a stack of cups 40 and cup feeding gears 146, 148 for singulating individual cups 40 from the stack of cups 40. The stack of cups 40 is biased downwardly by a weight 160, and each cup includes a bead 152 to be engaged by the gears 146, 148. During operation of the dispenser, the gears 146, 148 rotate to feed the cups 40 downwardly and drop the lowest cup into a compartment 154 for subsequent filling. Leof fails to teach or suggest a transfer mechanism for selectively inserting and removing the cups 40 between the gears 146, 148.

The Applicant respectfully submits that the Examiner's combination of Lemaire and Leof does not teach or suggest all of the features claimed in independent Claim 10. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." See MPEP § 2143.03. Specifically, the combination of Lemaire and

Leof does not teach or suggest a transfer mechanism including a lifter, the same lifter being movable relative to a tray to both selectively insert and remove the tray between first and second rotatable members.

Furthermore, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." See MPEP § 2143.01. There is no teaching or suggestion in Lemaire or Leof discussing the desirability of modifying Lemaire's station 3 or storage magazine 13 to include Leof's gears 146, 148. Lemaire does not disclose the specific structure of either the station 3 or the storage magazine 13, nor does Lemaire disclose how the goblets R are singulated by the station 3 or nested in the storage magazine 13. Indeed, Lemaire cannot contemplate the desirability of Leof's gears 146, 148 because Lemaire did not first contemplate the structure of either the station 3 or the storage magazine 13.

Accordingly, the Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of independent Claim 10.

Claims 2-8, 11-20, and 24-26 are each ultimately dependent upon independent Claim 10, and are believed to be allowable based upon independent Claim 10 and upon other features and elements claimed in Claims 2-8, 11-20, and 24-26 but not discussed herein.

Applicant has rewritten objected-to Claim 21 in independent form including the limitations of the base claims (Claims 10, 19, and 20). As such, newly-independent Claim 21 is allowable.

Independent Claim 27 recites (underlining added for emphasis):

A method for storing trays, comprising:
transporting a first tray to a transfer position;
lifting the first tray from the transfer position to a storage position;
supporting the first tray in the storage position by two opposed rotatable members; and
lowering the first tray from the storage position to the transfer position.

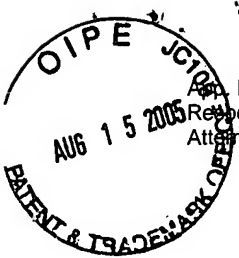
Neither Lemaire, Leof; nor their combination teach or suggest a method for storing trays including lifting a tray from a transfer position to a storage position, supporting the tray in the storage position by two opposed rotatable members, and lowering the tray from the storage position to the transfer position. Rather, Lemaire discloses the pusher 11 lowering a goblet R onto the conveyor C, transporting the goblet R away from a position beneath the station 3 toward a position beneath the storage magazine 13, and lifting the goblet R with the pusher 10 toward the storage magazine 13. Lemaire fails to teach or suggest that either of the pushers 10, 11 can raise a goblet R from a position beneath the station 3 or storage magazine 13, and lower the goblet R back to the same position beneath the station 3 or storage magazine 13.

Leof suffers from the same deficiencies as Lemaire. Leof discloses rotating opposed gears 146, 148 to singulate and dispense individual cups 40 from a stack of cups 40. Leof fails to teach or suggest that the cups 40 can be lifted from a transfer position to a storage position between the gears 146, 148, then lowered from the storage position back to the transfer position. Indeed, the stack of cups 40 is manually inserted into the dispenser, and the weight 160 biases the cups 40 downwardly toward a position between the gears 146, 148 as the cups 40 are singulated and dispensed by the gears 146, 148. Once the cups 40 are dispensed into the compartment 154, the cups 40 can not be returned to a position between the gears 146, 148.

The Applicant respectfully submits that the Examiner's combination of Lemaire and Leof does not teach or suggest all of the features claimed in independent Claim 27. Specifically, the combination of Lemaire and Leof does not teach or suggest a method for storing trays including lifting a tray from a transfer position to a storage position, supporting the tray in the storage position by two opposed rotatable members, and lowering the tray from the storage position to the transfer position.

Accordingly, the Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of independent Claim 27.

Claims 28-30 are each ultimately dependent upon independent Claim 27, and are believed to be allowable based upon independent Claim 27 and upon other features and elements claimed in Claims 28-30 but not discussed herein.



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CONCLUSION

In view of the amendments and remarks presented herein, it is respectfully submitted that the claims as amended are in condition for allowance. The Applicant kindly requests that the Examiner telephone the attorneys of record in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,

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